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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,306	07/07/2000	WILSON ZEHR	109912-130437	7042

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EXAMINER

SALAD, ABDULLAHI ELM

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 06/16/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/581,306

Applicant(s)

ZEHR ET AL.

Examiner

Salad E Abdullahi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. In view of the appeal brief filed on 4/26/2004, PROSECUTION IS HEREBY REOPENED. as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Applicant's arguments with respect to claims 1-6 and 8-15 have been considered but are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that

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the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 4, 5, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell U.S. Patent No. 5,805,810[hereinafter Maxwell].

As per claim 1, Maxwell discloses a mail delivery apparatus for delivery of mail to users physical address (intended recipient's physical address) comprising: a print server (see fig. 2, element 18) which includes: a storage device (see fig. 2, element 18); and a processor connected to the storage. device (see fig.2, element 18), the storage device storing:
a program for controlling the processor (see col. 3, lines 20-33 and see col.5, lines 1860); and

- the processor operative with the program to receive an electronic message that includes message attributes including a message recipient and printer criteria (i.e. printer proximity) (see col.13, line 33 to col. 14, line 67);
- determine a recipient physical address responsive to the message recipient attribute contained within the electronic message (see col. 13, lines 33-50);

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- determining a printer location near or proximate or closest to the recipient of the electronic content), (see col.13, line 33 to col. 14, line 67).
- selecting a printer location near the recipient of the electronic mail (see col.13, line 33 to col. 14, line 67) and
- sending the electronic content to the selected printer location (see col.13, line 33 to col. 14, line 67).

Maxwell is silent the details such as:

compare the message recipient physical address with the plurality of printing locations.

Nonetheless, comparing the message recipient physical address with plurality of printing location would have been an obvious modification if not inherent to Maxwell's system. Furthermore, Maxwell teaches an apparatus for receiving an electronic message which includes a sender and recipient identifiers, locates in a recipient database an identifier for the recipient, generates a mail object from the electronic message and sends the mail object to a printer station near the physical address of the recipient (see col. 3, lines 20-34 and col. 14, lines 35-67). Hence, one having ordinary skill in the art would readily recognized by sending the mail object to a printer location near the physical address of the recipient Maxwell's system compares the message recipient physical address with the plurality of printing locations. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to compare the message recipient physical address with the plurality of printing locations in order

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route the mail object the closest printing station to the electronic mail recipient, thus ensuring mail object be received in a timely manner.

In considering claim 4, Maxwell discloses a system, wherein the database further including a plurality of advertisements, advertising attributes and recipient demographics, in which the processor is further operative with the program to attach the selected advertisements to the electronic message (see col. 14, lines 30-35).

As per claim 5, Maxwell discloses a method for converting an electronically generated message to a physical mail object to be delivered to a mail recipient physical mail address delivery comprising:

- accessing an intermediate node (print server) from a sender's node on a global communication network (see fig. 2, and col. 5, lines 43-60)
- after accessing the intermediate node including, transmitting information to the intermediate node including message, message recipient and printing criteria (i.e. printer proximity) (see col.13, line 33 to col. 14, line 67);
- determine a recipient physical address responsive to the message recipient attribute contained within the electronic message (see col. 13, lines 33-50);
- locating in a database the physical address information of the mail object (see col. 3, lines 20-34 and col. 14, lines 35-67).

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- determining a printer location *near or proximate or closest* to the recipient of the electronic content), (see col.13, line 33 to col. 14, line 67).
- selecting a printer location near the recipient of the electronic mail (see col.13, line 33 to col. 14, line 67) and
- sending the electronic content to the selected printer location (see col.13, line 33 to col. 14, line 67).

Maxwell is silent the details such as:

compare the message recipient physical address with the plurality of printing locations.

Nonetheless, comparing the message recipient physical address with plurality of printing location would have been an obvious modification if not inherent to Maxwell's system. Furthermore, Maxwell teaches an apparatus for receiving an electronic message which includes a sender and recipient identifiers, locates in a recipient database an identifier for the recipient, generates a mail object from the electronic message and sends the mail object to a printer station near the physical address of the recipient (see col. 3, lines 20-34 and col. 14, lines 35-67). Hence, one having ordinary skill in the art would readily recognized by sending the mail object to a printer location near the physical address of the recipient Maxwell's system compares the message recipient physical address with the plurality of printing locations. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to compare the message recipient physical address with the plurality of printing locations in order

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route the mail object the closest printing station to the electronic mail recipient, thus ensuring mail object be received in a timely manner.

As per claim 11, Maxwell discloses a method for using a computer to facilitate communication between a message sender and at least one intended recipient comprising

- inputting into a computer a message; (see fig. 2, col. 3, lines 20-34 and col. 5, lines 43-60).
- inputting into a computer a recipient physical address corresponding to the intended recipient of the message (see col. 3, lines 20-34 and col. 14, lines 35-67).
- outputting the message and the recipient physical address electronically to a mail server (see fig. 2, and col. 5, lines 43-60).
- distributing the message to a selected one of the plurality of printing locations (col. 5, lines 43-60)
- printing the message at the selected one of the plurality of sending the electronic content to the selected printer location (see col.13, line 33 to col. 14, line 67).

Maxwell is silent the details such as:

compare the message recipient physical address with the plurality of printing locations.

Nonetheless, comparing the message recipient physical address with plurality of printing location would have been an obvious modification if not inherent to

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Maxwell's system. Furthermore, Maxwell teaches an apparatus for receiving an electronic message which includes a sender and recipient identifiers, locates in a recipient database an identifier for the recipient, generates a mail object from the electronic message and sends the mail object to a printer station near the physical address of the recipient (see col. 3, lines 20-34 and col. 14, lines 35-67). Hence, one having ordinary skill in the art would readily recognize by sending the mail object to a printer location near the physical address of the recipient Maxwell's system compares the message recipient physical address with the plurality of printing locations. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to compare the message recipient physical address with the plurality of printing locations in order to route the mail object to the closest printing station to the electronic mail recipient, thus ensuring the mail object be received in a timely manner.

In considering claim 12, Maxwell discloses a system, wherein the step of determining proximity of plurality of printing locations to the recipient of physical address (see col. 14, lines 1-67).

Claim Rejections - 35 USC 1 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 2, 6, 8, 9, and 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell as applied to claims 1, 5 and 11 above and further in view of Yacoub U.S. Patent No. 6,452,692[hereinafter Yacoub].

As per claim 2, Maxwell is silent regarding: the print server further query the printing locations having a desired set of attributes responsive to the printing criteria responsive to the printing criteria contained with electronic message and receive replies from the printing locations responsive to the query.

Yacoub, in analogous art discloses a print server system for receiving preference for print jobs including:

the database contains attributes of a plurality of printing locations (see col. 14, lines 17-67);

receiving print criteria (attributes) (see the abstract); query the printing locations having a desired set of attributes responsive to the printing criteria attributes contained within the print request (see the abstract and fig. 2, lines 28-60). select one of the printing locations (see the abstract and fig. 2, lines 28-60); and send the electronic message to the selected printing location (see the abstract and fig. 2, lines 28-60). Therefore, it would have been obvious to having ordinary skill in the art presented with teaching of Yacoub to Modify Maxwell by utilizing the print job processing mechanism as taught by Yacoub in order to enable network users to only choose job-relevant preferences such as the quality and speed without having to determine which printer to send the print job [see col. 2, lines 17-20].

As per claim 6, Maxwell is silent regarding: the print server further

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query the printing locations having a desired set of attributes responsive to the printing criteria responsive to the printing criteria contained with electronic message and receive replies from the printing locations responsive to the query.

Yacoub, in analogous art discloses a print server system for receiving preference for print jobs including:

the database contains attributes of a plurality of printing locations (see col. 14, lines 17-67);

receiving print criteria (attributes) (see the abstract); query the printing locations having a desired set of attributes responsive to the printing criteria attributes contained within the print request (see the abstract and fig. 2, lines 28-60). select one of the printing locations (see the abstract and fig. 2, lines 28-60); and send the electronic message to the selected printing location (see the abstract and fig. 2, lines 28-60). Therefore, it would have been obvious to having ordinary skill in the art presented with teaching of Yacoub to Modify Maxwell by utilizing the print job processing mechanism as taught by Yacoub in order to enable network users to only choose job-relevant preferences such as the quality and speed without having to determine which printer to send the print job [see col. 2, lines 17-20].

In considering claims 8, Yacoub, discloses a system, wherein the information about the printer includes geographic location, printing capability or capacity (see col. 14, lines 17-67).

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In considering claim 9, Yacoub, discloses a system, wherein the information about the printer includes geographic location, printing capability or capacity (see col. 14, lines 17-67).

As per claim 13, Maxwell is silent regarding: the print server further query the printing locations having a desired set of attributes responsive to the printing criteria responsive to the printing criteria contained with electronic message and receive replies from the printing locations responsive to the query.

Yacoub, in analogous art discloses a print server system for receiving preference for print jobs including:

the database contains attributes of a plurality of printing locations (see col. 14, lines 17-67);

receiving print criteria (attributes) (see the abstract); query the printing locations having a desired set of attributes responsive to the printing criteria attributes contained within the print request (see the abstract and fig. 2, lines 28-60). select one of the printing locations (see the abstract and fig. 2, lines 28-60); and send the electronic message to the selected printing location (see the abstract and fig. 2, lines 28-60). Therefore, it would have been obvious to having ordinary skill in the art presented with teaching of Yacoub to Modify Maxwell by utilizing the print job processing mechanism as taught by Yacoub in order to enable network users to only choose job-relevant preferences such as the quality and speed without having to determine which printer to send the print job [see col. 2, lines 17-20].

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In considering claim 14, Yacoub, discloses a system, wherein the information about the printer includes geographic location, printing capability or capacity (see col. 14, lines 17-67).

4. Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell as applied to claims 1 and 11 above and further in view of Heiden U.S. Patent No. 6,408,286[Heiden].

In considering claim 3, although, Maxwell and Yacoub disclose substantial features of the claimed invention, they are silent the database: storing a user record, said record having a counter measuring use of the mail delivery system and operative with a promotional program to effect awarding of prizes to the user. Heiden in analogous art, discloses a system a promotional program used within mail delivery system, including a user record which contains plurality of demographic information and/or indications of the behavior or status of the target audience or users (i.e. income or age and other statistics which could obviously include a measure of the system usage) (see col. 7, line 30 to col. 8, line 67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention presented with the teaching of Heiden to modify the system presented by Maxwell and Yacoub by employing the product distribution mechanism with promotional program as taught by Heiden such that user can be rewarded with their frequent interaction with the system, thereby enhancing the mail distribution system productivity.

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5. Claim 10, is rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell U.S. Patent No. 5,805,810, and Yacoub U.S. Patent No. 6,452,692 as applied to claim 6 above, and further in view of Heiden U.S. Patent No. 6,408,286[hereinafter Heiden].

In considering claim 10, although, Maxwell and Yacoub disclose substantial features of the claimed invention, they are silent the database: storing a user record, said record having a counter measuring use of the mail delivery system and operative with a promotional program to effect awarding of prizes to the user. Heiden in analogous art, discloses a system a promotional program used within mail delivery system, including a user record which contains plurality of demographic information and/or indications of the behavior or status of the target audience or users (i.e. income or age and other statistics which could obviously include a measure of the system usage) (see col. 7, line 30 to col. 8, line 67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention presented with the teaching of Heiden to modify the system presented by Maxwell and Yacoub by employing the product distribution mechanism with promotional program as taught by Heiden such that user can be rewarded with their frequent interaction with the system, thereby enhancing the mail distribution system productivity.

In considering claim 15, although, Maxwell and Yacoub disclose substantial features of the claimed invention, they are silent the database: storing a user record, said record having a counter measuring use of the mail delivery system

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and operative with a promotional program to effect awarding of prizes to the user. Heiden in analogous art, discloses a system a promotional program used within mail delivery system, including a user record which contains plurality of demographic information and/or indications of the behavior or status of the target audience or users (i.e. income or age and other statistics which could obviously include a measure of the system usage) (see col. 7, line 30 to col. 8, line 67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention presented with the teaching of Heiden to modify the system presented by Maxwell and Yacoub by employing the product distribution mechanism with promotional program as taught by Heiden such that user can be rewarded with their frequent interaction with the system, thereby enhancing the mail distribution system productivity.

CONCLUSION

6. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 703-308-8441. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to: (703) (872-9306).


Abdullahi Salad
Examiner Au 2157
6/6/2004